

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-4 are pending in this application. Claim 1 is independent. The remaining claims depend directly from claim 1. Claims 5 and 6 have been cancelled by this reply. The Examiner has rejected all of claims 1-6 over the '152 Patent and/or the '935 Patent under "35 USC 102/103" as lacking "essential novelty." Because "essential novelty" is not a recognized concept in U.S. Patent law, and because the rejection does not make clear whether the rejection is two separate rejections over each reference or a single rejection over the combination, Applicant finds it difficult to accurately respond. For the purpose of clarity, Applicant will consider the omnibus rejection to in fact be two individual rejections under 35 U.S.C. § 102 and a single combination rejection under U.S.C. § 103. Should this consideration not agree with the Examiner's viewpoint, the Examiner is respectfully requested to more clearly explain the basis for the rejections, in compliance with the guidelines set forth in the M.P.E.P.

Rejection(s) under 35 U.S.C § 102

Claims 1-6 stand rejected under 35 U.S.C. § 102 as anticipated by European Patent No. 0 706 152 ("the '152 Patent") or alternatively, anticipated by European Patent No. 0 737 935 ("the '935 Patent"). Claims 5 and 6 have been cancelled in this reply. Thus, this rejection is now moot with respect to those claims. This rejection is respectfully traversed with respect to the remaining claims.

Claim 1 recites a method for producing a card including an encapsulated portable object, namely, an integrated circuit. Specifically, the card is produced by mounting a chip onto a support sheet ((12) in Figure 3 of the Applicant's Specification) and subsequently laminating the support sheet, with an incorporating sheet ((18) in Figure 3 of the Applicant's Specification) to obtain a first rolled unit. The first rolled unit is subsequently covered with external covering sheets ((19) and (20) in Figure 5 of the Applicant's Specification). The aforementioned process recited in claim 1 allows a user to make contactless cards using *one* type of plastic (*e.g.*, PVC) by performing a *two*-step process. Further, by making contactless cards using the present invention, the user has the option to produce the first rolled unit and then store it for a period of time prior to adding the external covering sheets, without the risk of damaging the chip or having appearance defects.

In contrast, the '152 Patent teaches that a method for making a contactless card in which all the elements of the contactless card are aligned and then placed under heat and pressure to produce the contactless cards in a *one*-step process. Specifically, referring to Figure 7, the '152 Patent teaches stacking a plastic support sheet (1), a plastic incorporating sheet (2), and two overlaying sheets (3), and then subjecting the entire stack of plastic sheets, including the chip (6), to heat and pressure to produce a contactless card (*see* col. 4, ll.30-46). However, the '152 Patent does not teach or suggest producing a contactless card using a two-step process as recited in claims. In fact, the '152 Patent actually teaches away from the claimed invention by suggesting the desirability of a one-step process. Thus, claim 1 is patentable over the '152 Patent. In addition, dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

The '935 Patent also discloses a method for making a contactless chip using a *one*-step process. Specifically, the '935 Patent discloses a chip card having a plastic support sheet (1), an incorporating layer (9), and two overlaying sheets (10) (*see* Figure 6E). The chip (6) is first mounted on the support layer (1). The support layer (1) with the mounted chip (6) is then attached to the incorporating layer (9) using a resin. The resulting structure is then layered, on the top and bottom, with the overlaying sheets (9) and the entire stack is then subjected to heat and pressure (*see* col. 7, ll. 15-50). However, the '935 Patent does not teach or suggest producing a contactless card using a two-step process as recited in claims. Thus, claim 1 is patentable over the '935 Patent. The dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being obvious over the '152 Patent in view of the '935 Patent. Claims 5 and 6 have been cancelled in this reply. Thus, this rejection is now moot with respect to those claims. This rejection is respectfully traversed with respect to the remaining claims.

As discussed above, the present invention is directed towards a method for producing a contactless chip using a two-step process. In contrast, both the '152 Patent and the '935 Patent teach a method for producing a contactless chip using a one-step process. Neither the '152 Patent nor the '935 Patent, when viewed separately or in combination, teach or suggest the invention as recited in claim 1. Thus, the claim 1 is patentable over the '135 Patent and the '935 Patent. The dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply to be fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669.013001). Further, the Applicant respectfully requests that the Examiner consider and return an initialed copy of the IDS filed October 26, 2001.

Respectfully submitted,

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